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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,161	05/23/2000	Paul Lapstun	NPX016US	9177

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

ABDULSELAM, ABBAS I

ART UNIT PAPER NUMBER

2674

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

*me*

**Office Action Summary**

Application No.

09/575,161

Applicant(s)

LAPSTUN ET AL.

Examiner

Abbas I Abdulsalam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Response to Arguments**

1. Applicant's arguments filed 07/26/02 have been fully considered but they are not persuasive.

Applicant argues that the present application and a co-pending application (application No. 09/575,172) do not claim common subject matter. However, the examiner disagrees and maintains the rejection for the reason set forth in the previous as well as the present office actions.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1-128 provisionally rejected under the judicially created doctrine of double patenting over claim 1-56 of co-pending Application No.09/575,172. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

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The subject matter claimed in the instant application is fully disclosed in the referenced co-pending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter, as follows:

Regarding claims 1 and 109, they are met by a co-pending application claim 1. However, the co-pending application claim 1 does not specifically state “coded data indicative of at least one interactive element”. The co-pending application claim 1 does teach “coded data indicative of a drawing field”.

Therefore, it would have been obvious to one skilled in the art to recognize that “one interactive element” as claimed in the instant application and “drawing field” as claimed the co-pending application both correspond to each other and perform the same function.

Regarding claims 2 and 110, they are met by a co-pending application claim 9. However, the co-pending application does not specifically state “a sensing device containing the identifying data and the identifying data being indicative of the identity of the user”. The co-pending application does teach “a sensing device indicating data indicative of the identity of the interface surface and generates movement data indicative of the sensing device’s movement relative to the interface surface”.

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Therefore, it would have been obvious to one skilled in the art to recognize that the two statements in both applications correspond each other and serve the same purpose.

Regarding claim 53, it is met by a co-pending application 29. However, the co-pending application does not specifically state “operating a computer software partly in reliance on the user data”. The co-pending application does teach “operating a computer software partly in reliance on the movement of data”.

Therefore, it would have been obvious to one skilled in the art to recognize that “user data” as claimed in the instant application and “movement of data” as claimed in the co-pending application correspond to each other and are functionally equivalent.

Regarding claim 54, it met by a co-pending application claim 37. However, the co-pending application does not specifically state to “identify user data from the identifying data”. However, the co-pending application does teach to “perform written gesture recognition in relation the movement of the data”.

Therefore, it would have been obvious to one skilled in the art to recognize the two statements in both applications correspond each other and serve the same purpose.

Regarding claims 3 and 111, they are met by the co-pending application claim.

Regarding claims 4 and 112, they are met by the co-pending application claims 5-6

Regarding claims 5, 15, 68- 69, 113 and 119 they are met by the co-pending application claim 2.

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Regarding claims 6-7, 16, 70, 114, and 120, they are met by the co-pending application claim 3.

Regarding claims 8-9 and 115-116, they are met by the co-pending application 31.

Regarding claims 10-12, 17-19, 22-24, 31, 64-66, 71-73 and 76-78, 117, 121-122, 126-128, they are met by the co-pending application claim 15.

Regarding claims 13-14, 67, 83-85 and 118, they are met by the co-pending application claims 11-12.

Regarding claims 55, 20, 74 and 123, they are met by the co-pending claim 30.

Regarding claims 21, 60-63, 75 and 124, they are met the co-pending claim 31.

Regarding claims 25-28, 46-48, 52 and 79-82, they are met by the co-pending application claims 16-17.

Regarding claim 29, it is met by the co-pending application claims 44-45.

Regarding claims 30 and 125, they met by the co-pending application claim 46.

Regarding claims 32 and 86, they are met by the co-pending application claim 12.

Regarding claims 33 and 87, they are met by the co-pending application claim 33.

Regarding claims 34, 38, 41 and 88, they are met by the co-pending application claim 35

Regarding claims 35-36, 39-40, 42 and 89-94, they are met by the co-pending application claim 36.

Regarding claims 37 and 56, they are met by the co-pending application claims 33-34.

Regarding claims 43-45, they are met by the co-pending application claims 4-5.

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Regarding claims 57-59, they are met by the co-pending application claim 40.

Regarding claims 95, and 100-102, they are met by the co-pending application claims 50-

51.

Regarding claims 49, 96 and 103, they are met by the co-pending application claim 45.

Regarding claims 97-99, they are met by the co-pending application claim 32.

Regarding claims 50-51 and 104-105, they are met by the co-pending application claim 44.

Regarding claim 106, it is met by the co-pending application claim 46.

Regarding claims 107-108, they are met by the co-pending application claims 52-53.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other co-pending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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3. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Abbas Abdulsalam** whose telephone number is **(703) 305-8591**. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard Hjerpe**, can be reached at **(703) 305-4709**.

**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Hand delivered responses should be brought to crustal park II, Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 2600 customer Service office whose telephone number is (703) 306-0377.



**RICHARD HJERPE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**

**Abbas Abdulsalam**

**Examiner**

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